

Application No. 10/789,776
Inventors: James Say, et al.
Application Filed: February 27, 2004
Response to Office Action mailed August 13, 2008

Remarks/Arguments

Reconsideration is respectfully requested. Claims 1-5 and 7-39 are pending.
Claims 1-5 and 7-39 are rejected.

For the reasons set forth below, Applicants respectfully submit that all pending claims are allowable.

I. Obviousness Rejections

Claims 1-5 and 7-39 are rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,088,608 (“Schulman”), in view of U.S. Patent No. 6,047,203 (“Sackner”). See Office Action page 3.

For the reasons set forth below, Applicants traverse the Examiner’s rejections and respectfully submit that all pending claims are allowable.

In maintaining the obviousness rejections, the Examiner concedes that Schulman does not teach “wherein the transmitter is configured to transmit three data points per minute to the receiver, said three data points corresponding to the detected one or more glucose levels” nor “wherein the transmitter is configured to transmit a current data point and at least one previous data point, said current data point and said at least one previous data point corresponding to the detected one or more glucose levels.” See Office Action, p.4. Nevertheless, in referring to the Sackner reference, the Examiner concludes that it would have been obvious to one skilled in the art to modify Shulman’s transmission rate in view of Sackner in order to conserve batter powering the electronics on Schulman’s glucose monitoring system. See Office Action, pp.4-5.

Applicants respectfully disagree.

Preliminarily, Applicants wish to remind the Examiner that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); see also MPEP Section 2143.03.

As to the disclosure of Schulman, while the Examiner refers to element 108 of Schulman as disclosing the claimed transmitter, as understood, element 108 of Schulman is a pad which, along with pads 109-111 are located on respective ends of the substrate 100 within the hermetically sealed portion 100 of the implanted sensor 10, and which provide electrical contact with the circuits and components within the hermetically sealed portion of the sensor 10. See Schulman, Col.5, lines 16-23; col. 8, lines 13-16; see also col.9, lines 7-14 and 24-29. Indeed, as understood, the pad 108 of Schulman is not configured to transmit signals corresponding to detected glucose levels as set forth in the pending claims.

As understood, the cited portions of the combined disclosure of Schulman and Sackner references, even assuming *arguendo* that the combination were proper, fail to disclose each limitation set forth in the pending claims of the present application.

Turning to the Sackner reference, Applicants do not dispute that Sackner discloses the NimShirt that transmits data at a rate ranging from approximately 25-200 points/second, and further, discloses transmitting an average one minute trend numerical value every five to ten minutes rather than the 25-200 points/second, and transmitting at this latter rate of 25-200 points/second, for example, when an adverse or preprogrammed event occurs to conserve batteries powering the electronics on the NimShirt. See Sackner, Col.2, lines 27-34.

In other words, as understood, Sackner discloses transmitting data with less frequency, and increasing the data transmission rate when an adverse or preprogrammed event occurs to conserve battery power – that is, transitioning to transmitting 25-200 points/second from transmitting once every five to ten minutes (of averaged one minute data) based on an adverse or programmed event occurrence.

On the other hand, as understood, Schulman is directed to a system for performing periodic integrity check of the sensor functions and/or parameters, and reporting the test results. See Schulman, col.3, lines 22-31; Abstract. Indeed, as described in Schulman, the system provides an implantable sensor and a means for

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automatically verifying the integrity of the sensor on a periodic/scheduled basis, and which eventually reports any out of tolerance conditions or problematic or informational data. See Schulman, col.14, lines 43-53.

As the Examiner is well aware, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007); See MPEP Section 2143.01. Furthermore, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in KSR).

The Examiner simply asserts that one skilled in the art would be motivated to modify Schulman’s transmission rate with that of Sackner to conserve the battery powering the electronics in Schulman’s system. See Office Action, p.5. However, as understood, Schulman’s system as described is neither specifically concerned with batteries nor the transmission of data in the context of battery power consumption. Indeed, as understood, Schulman is devoid of any discussion related to power management, nor in the context of the general data communication of the integrity test results for processing. To simply take one sentence from the Sackner reference as the rationale for combining its disclosure with Schulman amounts to nothing more than taking the pending claims as a template for a hindsight reconstruction of the embodiments defined thereby.

Such hindsight reconstruction is impermissible. Indeed, “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art

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to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Accordingly, Applicants traverse the Examiner's rejections and respectfully submit that pending claims 1-5 and 7-39 are allowable.

Furthermore, while the Examiner has rejected all pending claims 1-5 and 7-39 as obvious over Schulman in view of Sackner, the detailed rejection of the pending claims set forth in the Office Action does not discuss the specific rejection of several of the pending dependent claims, such as, for example, but not limited to claim 7, which is directed to the three data points including a current data point and two previous data points. To this end, and to the extent that each of the pending dependent claims are rejected as obvious over the cited references, Applicants respectfully request the Examiner to provide the basis for such rejection for each dependent claim.

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In view of the foregoing, Applicants respectfully submit that all pending claims are allowable, and request the Examiner's early examination of the pending claims in the present application. In the event that the Examiner deems a telephonic or in person discussion would be helpful in advancing the prosecution of the present application, Applicants respectfully request the Examiner to contact the Applicants' representative at (510) 652-6418, x82.

Respectfully submitted,
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